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**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s) : Daniel J. REESE et al.  
Appl. No. : 09/819,788  
Filed : March 28, 2001  
For : MULTI VIDEO DEVICE CONTROL AND EXPANSION  
METHOD AND APPARATUS  
  
Art Unit : 2621  
Examiner : Huy Thanh NGUYEN  
Conf. No. : 2648

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**APPELLANTS' REPLY BRIEF IN RESPONSE TO  
EXAMINER'S ANSWER (UNDER 37 C.F.R. § 41.41)**

S I R :

In response to the Examiner's Answer mailed on July 19, 2007, regarding the above-identified application, Applicants submit the following arguments in support of the appeal of the final rejection.

## **ARGUMENT**

### **I. Introduction**

The following grounds of rejection are presented for review on appeal in this case:

(A) Whether pending claims 1-6, 10-11 and 17-18 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,963,995 ("Lang").

(B) Whether claim 7 is unpatentable under 35 U.S.C. § 103(a) over Lang in view of U.S. Patent No. 5,930,473 ("Teng").

(C) Whether claims 8 and 9 are unpatentable under 35 U.S.C. § 103(a) over Lang in view of U.S. Patent No. 5,666,363 ("Osakabe").

(D) Whether claims 12-16 are unpatentable under 35 U.S.C. § 103(a) over Lang in view of U.S. Patent No. 6,330,025 ("Arazi").

(E) Whether claim 19 is unpatentable under 35 U.S.C. § 103(a) over Lang in view of U.S. Patent No. 6,330,025 ("Arazi").

(F) Whether claim 20 is unpatentable under 35 U.S.C. § 103(a) over Lang in view of Arazi, and further in view of U.S. Patent No. 5,666,363 ("Osakabe").

#### **A. Rejection of Claims 1-6, 10-11 and 17-18 under 35 U.S.C. § 102(b)**

Claims 1-6, 10-11 and 17-18 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,963,995 ("Lang").

Independent claim 1 recites, in relevant parts, "a network port for communicatively connecting the DVRC with at least one other apparatus on a network"; "the DVRC is further adapted to receive through the network port a second selection of digitized video signals, wherein the second selection includes one or more digitized video signals being transmitted by a second other apparatus on the network"; and "the DVRC is adapted to facilitate designation of the digitized video signals of the second selection."

With respect to the claimed feature that the DVRC stipulates the video signals of the second selection, i.e., “**facilitate designation of the digitized video signals of the second selection**,” the Examiner once again contends in the Examiner’s Answer that this claimed feature is taught by Lang since “Lang teaches the DVCR using network port 22 for receiving the one or more programs from second other DVCRs” and “Lang teaches the DVCR having a key pad and circuit elements for selecting connecting to second other DVCRs (second other apparatus) and receiving one or more digitized video signals from the second other DVCRs.” (Examiner’s Answer, p. 14). Applicants note that this argument is a mere repetition of the Examiner’s unsupported arguments previously made in the Advisory Action, i.e., “each apparatus can facilitate designation of the digital video signals of the second selection or first selection since each apparatus has means to enable the selections of transmitting the digitized video signals and receiving the digitized video signals by using the key board and buttons on each apparatus,” and this assertion is not only **completely unsupported** by any disclosure in Lang, but also **legally flawed to the extent the Examiner is invoking the doctrine of inherent disclosure**.

To the extent the Examiner is contending that the claimed feature of “facilitat[ing] designation of the digitized video signals of the second selection” is inherently disclosed in Lang since it is possible to achieve “transmitting the digitized video signals and receiving the digitized video signals by using the key board and buttons on each apparatus,” this assertion is completely flawed since Lang merely discloses a point-to-point connection rather than a network connection, and there is **no “basis in fact and/or technical reasoning to reasonably support the determination” that the claimed “facilitat[ing] designation of the digitized video signals of the second selection” would necessarily have to be present** even if the system of Lang were somehow presented in a network setting (which is clearly not true). To the extent that the Examiner may be relying on the **doctrine of inherent disclosure**, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Although the Examiner has previously cited col. 7, l. 30-45; col. 8, l. 30-60; and col. 9, l. 55 – col. 10, l. 5, of Lang as teaching the above-recited feature of claim 1, **nothing in Lang even remotely suggests that video recorder 10 controls a signal source connected via switches 35, 36, 37, let alone that any such control relates to the determination of the second selection**.

Independent of the above, the Examiner has not provided any evidence that the disclosure of Lang would enable a person having ordinary skill in the art to practice the claimed invention, which requirement must be satisfied to establish an anticipation rejection. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). Given the fact that there is no disclosure in Lang suggesting anything even remotely related to the claimed feature of “facilitat[ing] designation of the digitized video signals of the second selection,” the Examiner simply cannot establish that the disclosure of Lang would enable a person having ordinary skill in the art to practice the claimed invention.

Independent of the above, to the extent the Examiner now contends in the Examiner’s Answer that port (22) is equivalent to the claimed “network port for communicatively connecting the DVRC with at least one other apparatus on a network” and the “network port” through which “a second selection of digitized video signals” are received, Applicants note that this is a third, different interpretation of the Lang reference asserted by the Examiner in an extremely incoherent effort to rationalize the rejection. Initially, the Examiner contended in the Final Office Action that Lang disclosed “**a network port (22)** for communicatively connecting the DVRC with at least one other apparatus on a network,” and that “DVRC is further adapted to receive through **the network port (36, 37, 35)** a second selection of digitized video signals.” Subsequently, the Examiner contended in the Advisory Action that “Lang teaches **a network port (18)** using fiber optic lines and **a network port (46, 22)** using telephone lines **for transmitting and receiving** the selection of the digitized video signals.” In view of the **three different interpretations of Lang asserted by the Examiner**, Applicants note that the Examiner’s arguments lack even a semblance of coherence.

Independent of the above, to the extent the Examiner contends in the Examiner’s Answer that both **elements 18 and 22** of Lang are equivalent to the claimed “network port,” Applicants note that this interpretation is clearly flawed. The Examiner’s asserted rationale is as follows: “The port 22 and 18 are network ports since they can transmit digitized video signals from a DVCR to a first other DVCR and receive digitized video signals from second other DVCR. The telephone lines that [are] connected to network port 22 and the optical line that [is] connected to the network 18 are network since the lines make a connection between a DVCR to any first and second other DVCRs (first other apparatus and second other apparatus) and transfers digitized video signals among the DVCR.” In essence, the Examiner is contending that **any port that makes a point-to-point connection to another DVCR is a**

network port. However, the Examiner's interpretation clearly violates the fundamental rule of claim interpretation, i.e., the claims should be given the broadest **reasonable** interpretation **that is consistent with the specification and the interpretation that those skilled in the art would reach**. (See M.P.E.P. 2111, citing In re Hyatt, 211 F.3d 1367 (Fed. Cir. 2000), and In re Cortright, 165 F.3d 1353 (Fed. Cir. 1999)).

The interpretation asserted by the Examiner completely ignores the fact that the present application describes the claimed invention in the context of an Ethernet network, which arrangement overcomes the deficiencies of the prior art arrangement of hardwiring each DVR to a central control station via a distinct, point-to-point wiring connection, (see "Related Art" section of the present application), and there is no reasonable basis for the Examiner to contend that those skilled in the art would interpret (in view of the specification disclosure) the claimed "network port" to encompass any port that merely makes a point-to-point connection to another port. Lang clearly indicates that audio/video transmitter/receiver 22 is connected to a conventional telephone connection, which is in turn connected to a video recorder, (see, e.g., col. 9, l. 59-62), which necessarily means the audio/video transmitter/receiver 22 is a modem that implements a **point-to-point connection to a second video recorder via a telephone line**. In addition, the port 18 of Lang is clearly indicated as a port for interfacing audio/video signals with a fiber optic line, which once again necessarily means the audio/video port 18 implements a point-to-point connection to a second video recorder (as clearly indicated by the explicit statement that "a video program may be communicated . . . from the first VCR-ET to a second VCR-ET," (col. 7, l. 61-63)). Accordingly, ports 18 and 22 of Lang cannot be interpreted as being equivalent to the claimed "network port" for a connection to a network.

Independent of the above, to the extent the Examiner cites col. 14, l. 54-68 of Lang for teaching "receiving a plurality of digital video programs or portions from another apparatus and transmitting a plurality of digital video programs or portions to another apparatus via a networking," the cited section (claim 30) merely recites "a plurality of audio/video transceivers, coupled via one or more communication links," and that each transceiver includes "input means for receiving audio/video source information," but there is no enabling disclosure regarding the "transfer network," let alone any suggestion that a transceiver "facilitates designation of the digitized video signals of the second selection."

For at least the foregoing reasons, claim 1 and its dependent claims 2-6 and 10-11 are not anticipated by Lang. Applicants note that claim 17 recites features substantially similar to the above-discussed features of claim 1, i.e., “a DVRC network port” and “the first DVRC is adapted to receive through the DVRC network port a selection of a digitized video signals,” so claim 17 and its dependent claim 18 are similarly not anticipated by Lang, at least for the reasons stated in connection with claim 1.

In view of all of the foregoing, reversal of the anticipation rejection is respectfully requested.

**B. Rejection of Claim 7 under 35 U.S.C. § 103(a)**

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 5,930,473 (“Teng”).

Claim 7 depends on claim 1. Furthermore, the teachings of Teng simply do not remedy the deficiencies of Lang as applied against parent claim 1, e.g., Teng similarly fails to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection,” as recited in amended claim 1. For at least these reasons, dependent claim 7 is not rendered obvious by the combination of Lang and Teng.

**C. Rejection of Claims 8 and 9 under 35 U.S.C. § 103(a)**

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 5,666,363 (“Osakabe”).

Claims 8 and 9 ultimately depend on claim 1. Furthermore, the teachings of Osakabe simply do not remedy the deficiencies of Lang as applied against parent claim 1, e.g., Osakabe similarly fails to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection,” as recited in claim 1. In addition, while the Examiner maintains in the Examiner’s Answer that col. 7, l. 15 to col. 8, l. 15 of Osakabe teaches the claimed feature that “the DVRC is further adapted to transmit a first control signal to the second other apparatus, wherein the first control signal designates the one or more video signals of the second selection of digitized

video signals to be transmitted by the second other apparatus,” as recited in claim 8, there is no reasonable interpretation of Osakabe that would support the Examiner’s assertion: Osakabe merely discloses that a TV set 10 sends a signal to a video recorder 20, in order to cause the video recorder to rerecord video data, but **nothing in Osakabe suggests that the video recorder generates this control signal**. In any case, one skilled in the art would not be motivated to combine the teachings of Osakabe with the teachings of Lang, since Lang provides no external control possibility of the video recorder via an external bus, as is required according to the approach of Osakabe using bus 1.

For at least the foregoing reasons, dependent claims 8 and 9 are not rendered obvious by the combination of Lang and Osakabe.

**D. Rejection of Claims 12-16 under 35 U.S.C. § 103(a)**

Claims 12-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 6,330,025 (“Arazi”).

Applicants note that claim 12 recites substantially similar features as those recited in amended claim 1. As discussed in connection with claim 1, Lang fails to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection.” In addition, Lang does not teach or suggest that the DVRC has a network port. Furthermore, the teachings of Arazi simply do not remedy the deficiencies of Lang as applied against claim 12. Accordingly, any combination of Lang and Arazi would fail to approximate the invention of claim 12.

Independent of the above, Applicants note that one of ordinary skill in the art would not be motivated to combine the teachings of Arazi with the teachings of Lang, since Lang relates to a classical video recorder which is only intended for the simultaneous processing of a single data source, and Lang does not teach or suggest anything regarding the processing of several data sources (e.g., video cameras) simultaneously. Therefore, one skilled in the art would have no reason to provide a plurality of video cameras in Lang. In addition, one skilled in the art would derive no suggestion from Arazi to connect both the DVRC and the DVR to a plurality of video cameras.

In response to the above arguments, the Examiner argues that “[n]owhere claim 12 recites that several data sources can be simultaneously processed.” However, this responsive argument by the Examiner completely misses the Applicants’ argument: claim 12 clearly recites “a first plurality of video cameras” and “a second plurality of video cameras,” and Applicants are noting that there would not be **any motivation to modify the teachings of Lang** by providing a plurality of cameras since Lang is a classical video recorder which is only intended for the processing of **a single data source**.

For at least the foregoing reasons, claim 12 and its dependent claims 13-16 are not rendered obvious by the combination of Lang and Arazi.

**E. Rejection of Claim 19 under 35 U.S.C. § 103(a)**

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 6,330,025 (“Arazi”).

Claim 19 depends on claim 17. Applicants note that claim 17 recites features substantially similar to the above-discussed features of claim 1, i.e., “a DVRC network port” and “the first DVRC is adapted to receive through the DVRC network port a selection of a digitized video signals,” so Lang fails to teach all of the features of claim 17 for the reasons stated in connection with claim 1. Furthermore, the teachings of Arazi simply do not remedy the deficiencies of Lang as applied against parent claim 17.

For at least these reasons, dependent claim 19 is not rendered obvious by the combination of Lang and Arazi.

**F. Rejection of Claim 20 under 35 U.S.C. § 103(a)**

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of Arazi, and further in view of U.S. Patent 5,666,363 (“Osakabe”).

Claim 20 depends on claim 19, which in turn depends on claim 17. As noted above, the combination of Lang and Arazi fails to teach or suggest all of the features of claims 17 and 19. Furthermore, the teachings of Osakabe simply do not remedy the deficiencies of Lang and Arazi as applied against parent claims 17 and 19. Accordingly, even if one assumes



for the sake of argument that there were some motivation to combine the teachings of the applied references in the manner asserted by the Examiner (with which conclusion Applicants do not agree), the asserted combination would fail to approximate the claimed invention of dependent claim 20.

For at least these reasons, the combination of Lang, Arazi and Osakabe does not render obvious dependent claim 20.

### CONCLUSION

For the preceding reasons, it is respectfully submitted that the rejections of claims 1-20 under 35 U.S.C. §§ 102(b) and 103(a) should be reversed.

While no fees are believed to be due in connection with this paper, the Office is authorized to charge any fees deemed necessary in connection with this paper to Deposit Account No. **11-0600 of Kenyon & Kenyon LLP**.

Respectfully submitted,

 (R. NO. 36,197)

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